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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,359	12/04/2000	Paul Moskowitz	1963-4937	6926

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EXAMINER

JANVIER, JEAN D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/730,359

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Jean D Janvier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10-12, 14, 20-27, 29-31, 33, 39-46, 48-50, 52 and 58-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-12, 14, 20-27, 29-31, 33, 39-46, 48-50, 52 and 58-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **Response to Applicant's Arguments**

Applicant's remarks regarding the restriction requirement were fully addressed in a prior correspondence and were not found to be plausible. Thus, the restriction requirement is herein made final and the Applicant is requested to cancel the withdrawn claims in a future correspondence.

### ***Status of the claims***

Claims 1-8, 10-12, 14, 20-27, 29-31, 33, 39-46, 48-50, 52 and 58-60 are being prosecuted and the remaining claims are being withdrawn from further consideration.

### **Claim Objections**

Claims 1, 20, 39 and 10, 29, 48 (including their dependent claims) are objected to because of the following:

Following claims 10, 29 and 48, "...recommendation relates to...." should apparently be --...recommendations relate to...--.

Following claims 1, 20 and 39 "...the update schedules of a web site are...." should apparently be --... the update schedule of a web site is ...--.

Concerning claim 21 "...the update schedule of a web site are...." should apparently be --... the update schedule of a web site is...--.

Appropriate corrections are required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ

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(BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art"

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because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter. In fact, the process or steps disclosed in independent claim 1 pertains to a manual process and therefore, the claim does not fall within the technological art. In other words, the steps or process of **receiving a web site update schedule..... and providing the update schedule.....**, as recited in claim 1, should be implemented via a device, such as a computer system, a database, a data communication, computer network, the Internet and so and so forth. Here, the step or process of receiving a **web site** update schedule does not necessarily imply the use of technology since the update schedule can be written manually on a piece of paper and sent via the Post Office to a requesting user.

Claim 58 is rejected under 35 U.S.C. 101 because the claimed invention pertains to a non-statutory class. Although a computer readable medium having encoded thereon a computer program or computer instructions is statutory, **however, claiming the computer program or a Software per se is not statutory. Applicant can amend the claim as suggested below to overcome this rejection.**

Claims 59 and 60 are rejected under 35 U.S.C. 101 because the claimed invention pertains to a non-statutory class. Although a computer readable medium having encoded thereon a computer program or computer instructions is statutory, however, claiming the computer program or a software per se is not statutory. Applicant can amend the claim as follows to overcome this rejection.

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A computer readable medium having encoded thereon a computer program comprising codes, **executed on a processor (optional)**, to perform the steps of:

receiving a consumer profile.....

receiving an advertisement profile....

comparing the advertisement.....

selecting the advertisement....

Following the amendment, all dependent claims should refer to \_-The computer readable medium of claim xx--.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).



Claims 1-8,10-12, 14, 20-27, 29-31, 33, 39-46, 48-50, 52 and 58-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Reisman, US Patent 6,594,692.

As per claims 1-8,10-12, 14, 20-27, 29-31, 33, 39-46, 48-50, 52 and 58-60, Reisman discloses a method of and a system for presenting electronic information products, such as magazine collections, and automated mass distribution of magazine updates and/or a plurality of web site updates from a remote server (host server) to a wide user base having a diversity of computer stations. To this end, a server-based update distribution service and web browser system with hyperlink redirection capabilities are provided (See abstract).

In general, Reisman teaches a system for providing a computer-implemented information transport software module usable with any of multiple electronic information products for mass distribution of electronic information objects to users of a diversity of uncoordinated communications-equipped computer stations (**providing a client Software that enables users using various processor-base terminals to communicate with a remote server or source over a communication network and receive therefrom electronic content**). The information transport software module (client Software) is **readily customized to an individual information product** (electronic content) to have a user interface (GUI) in said information product for activation of automated transport of an information object (such as an update) between a remote object source and a user's computer station (the client Software is customized to an individual

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electronic content to facilitate the receipt of an automated update directly from a remote server). The information transport module contains user communications protocols specifying user station functions of the automated object transport and the object source is supplied with source communications protocols specifying source functions of the automated object transport. The source communications protocol is co-operative with the user communications protocol and knows the **characteristics** of the user communications protocol, so as to be able to effect the information object transport in unattended mode after initiation (the client is configured to the user's computer's specifications so as to enable the user to automatically receive from the remote source (distribution source) an update of an electronic content in unattended fashion after an initial use or request- Col. 5: 1-20). The present system enables, for example, an information product (electronic content) vendor to supply an automated (or unattended) update (or other information transport facility) of an electronic content to a mass market of computer users in real-time (col. 5: 21-39).

Preferably, the user's communications protocol specify parameters such as a source address (the web site address of an update to be received) and object parameters such as file name or names, file size, location content and format (specifying requested electronic content and/or update attributes) are specified, as appropriate, in either the user's communication protocols or the source communications protocols, or both **(updates or web site updates are customized based on the user's specified attributes or interest)**. Such object specification can be listed in an object manifest (file) stored at the user's station, which preferably, for better control of the transport operation, is sent to the remote object source as a verifier or identifier (col. 5: 64 to col. 6: 6). Here, any user

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can, easily and with varying degrees of **automaticity or automation**, up to complete automation after initiation (use) of a transport (client software) or upon arrival of a **scheduled transport time**, obtain an update object and smoothly integrate it with an original product or product shell (electronic content). In a highly automated embodiment, a containing information product (electronic content), configured with transporter (embedded client software module), is pre-coded with an update, reporting, **or other schedule** and, referencing the user's system clock, **prompts the user for initiation of a transport operation at a scheduled date** after distribution of the containing product (electronic content), or fetches a **schedule**. If the user's system is shut down when the pre-scheduled date arrives to the user's station, a prompt is made at the first time the user's system boots or after the product is used after that date the scheduled update is being used (col. 6: 60 to col. 7: 7; col. 7: 22-28; col. 7: 48-57).

The present system makes possible various new information distribution methods and services. The object source can be a remote server (a web server related to a web site) equipped with a cooperative communication module closely molded to work effortlessly with the information transporter for distributing objects, including updates, to a wide base of registered users or subscribers. Such a remote server (**associated with a distributor or distribution medium or platform**) can be linked to a vendor or gatewayed to other information object sources or electronic publishers' **web sites or web servers, storing in a database electronic content and updates, to receive therefrom the updates of electronic content (or schedule update of the site) or to scan or scrawl the database to obtain therefrom the updated electronic content (or the web site update schedule)** and exploit its smooth and efficient information transport capabilities to act as a

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**distribution point for such vendors, sources or publishers or other third parties (the remote server is configured as a distribution medium to receive from a registered vendor's or publisher's web server updates or schedule of the updates from the web site, related to the web server, as defined by the user or to scan or scrawl the vendor's web site database to obtain the updates or schedule of the updates therefrom-Col. 9: 31-49; col. 54: 16-19).**

It is further understood that the user's previously visited web sites, vendor's or sponsor's supplied lists to the user, other offline of URLs of potential interest to the user **and online retrievals** are used to assemble or build a customized package, comprising of hyperlinked collections of content elements (including updates) retrieved from multiple web sites or Internet locations or other appropriately dispersed source (using, for the user (tracking the user's interactions and recommending additional web sites to the user accordingly- Col. 53: 50-55:17).

See in general col. 20: 35 to col. 23: 37; col. 29: 10-25; col. 39: 18-53; col. 53: 51 to col. 55: 17).

The entire reference is relevant to the claimed invention and other portions of the reference may be used in a subsequent Action to better address the claimed invention; if need, without triggering a new ground of rejections.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 20, 39 and 58-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Nobakht, US Patent 6,587,873B1.

As per claims 1, 20, 39 and 58-60, Nobakht discloses a system server for a channel-based network including one or more Internet sites and one or more user terminals. The system server includes a channel table database storing a master channel table that includes a list of channel numbers, each channel number having an associated Internet address and an associated Internet site name. Each Internet site of the network is

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addressable by an associated Internet address stored in the master channel table. The system server includes a network database and an update manager database. The system server identifies each user terminal requesting service by comparing transmitted identification information with authorized user information stored in the network database. The system server also compares a channel table version number from the requesting user terminal with a version number stored in the update manager database that is associated with the master channel table, and notifies each requesting user terminal when updated channel table information is available. At each user terminal, a user reads the channel numbers and associated Internet site names from a menu displaying the downloaded channel table, selects an Internet site name from the displayed menu, and enters the channel number associated with the selected Internet site name using an input device that is similar to a television remote control (See abstract; col. 1: 58 to col. 2: 45).

FIG. 5(C) is a diagram depicting the data fields stored in update manager database 418. As described in additional detail below, update manager database 418 is used to coordinate the download of updated channel table information to the user terminals connected to channel-based network 100. To facilitate the update process, update manager database 418 stores user and terminal information (which may be shared from network database 416), a list of currently-available channel table versions, and an update schedule. The current channel table version information is used to determine whether a user terminal is storing the most recently updated version of master channel table 112-A. The update schedule information is used to coordinate the updating of all user terminals connected to the network to prevent strain on server 110 (e.g., due to too many update process requests at the same time). In one embodiment, the update schedule information

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may assign groups of users certain time periods during which update processes may be performed. In another embodiment, server 110 may monitor and limit the number of update processes being performed at a particular time. Those of ordinary skill in the art will recognize that a wide range of additional data fields may be provided in update manager database 418 (col. 9: 62 to col. 10: 17).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 6, 101, 486 discloses a method and system for gathering and storing customer profile data when the customer accesses a website location. Dynamic content messages from company marketing material are selected in accordance with the profile data and used to provide a customized webpage to the customer. In addition, a customer service representative can provide real-time updates to the customized webpage when the customer contacts a customer service representative to place a product or service order.

Any inquiry concerning this communication from the Examiner should be directed to Jean D. Janvier, whose telephone number is (571) 272-6719. The aforementioned can normally be reached Monday-Thursday from 10:00AM to 6:00 PM EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Eric W. Stamber, can be reached at (571) 272- 6724.

Non-Official Draft- 571-273-6719

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06/22/05

JDJ

Jean D. Janvier

Patent Examiner

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**JEAN D. JANVIER**  
**PRIMARY EXAMINER**

*Janvier Jean Dario*